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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,852	11/19/2003	Neil R. Diener	Cognio 109US	1708

27896 7590 03/21/2006

EDELL, SHAPIRO & FINNAN, LLC
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EXAMINER

CUMMING, WILLIAM D

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,852	DIENER, KLOPER, & COLLINS	
	Examiner	Art Unit	
	WILLIAM D. CUMMING	2617	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-78 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/24/04 & 3/19/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 76-78, drawn to telecommunication system for a radiotelephone system having usage measurement, classified in class 455, subclass 405.
 - II. Claims 56-76, drawn to telecommunication system which has a transmitter and receiver at separate stations having distortion, noise, or other interference prevention, reduction or compensation, classified in class 455, subclass 63.1.
 - III. Claims 1-55, drawn to telecommunication system which has a transmitter and receiver at separate stations having measuring, testing or monitoring system or part, classified in class 455, subclass 67.11.
2. The inventions are distinct, each from the other because of the following reasons:
 - a. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as usage measurement. See MPEP § 806.05(d).

- b. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
 - c. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper.
 - d. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
3. Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
4. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, *"the list may not be incorporated into the specification but must be submitted in a separate paper."* Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

6. Electronic Processing of Information Disclosure Statement SUMMARY

As part of its e-commerce program, the United States Patent and Trademark Office (USPTO) beginning on January 18, 2006, will begin electronic processing of the list of citations (e.g., forms 1449 or SB 08) submitted as part of an information disclosure statement (IDS) submitted in applications stored by the USPTO in image form. The USPTO will provide examiners with a tool to electronically annotate citations and electronically sign the IDS when reviewing cited references. The electronically processed IDS will be stored in the USPTO's official record as an entry in the application's image file wrapper and a copy will be mailed to applicant as part of an Office action.

PLANNED IMPLEMENTATION

The USPTO plans to make the tool to electronically process IDSs available to examiners in a staged release beginning on January 18, 2006, and ending in February 2006. Accordingly, applicants that receive numerous Office actions may receive some IDS annotated by hand while receiving other IDSs annotated by electronic means for a limited time period.

ELECTRONIC ANNOTATION AND SIGNATURE

The electronic annotation, similar to hand written annotations, will cause the initials of the reviewing examiner to be applied to either: (1) the immediate left of each citation reviewed; or (2) the immediate left of the first of several consecutive citations and the left of the last of the consecutive citations reviewed with a line connecting the initials. Citations that have not been considered will be lined through.

The electronic signature will be in the form /John Q. Examiner/ at the bottom of the last sheet of citations of an IDS. The examiner may elect to electronically sign each sheet of citations considered.

Comments regarding this notice may be directed to Robert A. Clarke, Deputy Director – Office of Patent Legal Administration, at robert.clarke@uspto.gov. Technical

questions regarding the tool for electronic processing of IDS may be directed to Michael Sigda, Manager – Electronic Patent File Unit, at michael.sigda@uspto.gov.

DATE: 01/24/06 /S/

7. The information disclosure statement filed march 19, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because some references do not have a date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Specification


8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 571-272-7861. The examiner can normally be reached on Monday-Thursday 11am-8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Harold Banks can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WILLIAM D. CUMMING
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wdc



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